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Filed: 12/05/2002  
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### REMARKS

Claims 1-20 are pending in the application. Claims 1, 5, 7, 15, 16, and 17 have been amended in order to address the formal issues raised by the Examiner in the most recent Office Action of September 9, 2004 (OA), and in addition claims 1 and 15 have been modified to more particularly point out the nature of the claimed composition, i.e. to indicate that the claimed composition is a lipstick composition. Support for the amendments are found in the original claims as well as the specification as a whole. In addition, Applicants note the objection to claims 7 and 15, which appears at page 2 of the OA. Claim 15 has been modified to replace "alkyl." with "alkyl;". With regard to the objection to claim 17, it would appear that the presentation of the claim available to the Examiner through the electronic form of the application does not reflect the correct form as originally filed. It is believed that the newly filed amended claims, which accompany this response, should provide claim 17 in the standard claim format and thus avoid this objection. Should the claim still appear incorrectly, the Examiner can so advise Applicants and appropriate correction will be made.

#### **Status of the Pending Claims:**

Claims 5, 7, and 16-18 stand rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. Claims 1-16, 18, and 19 stand rejected under 35 U.S.C. §103(a) as unpatentable over Jacks et al. (U.S. 5,690,918) in view of Croda (Personal Care, Super Sterol Ester) and Mercado et al. (U.S. 4,996,044). Claims 17 and 20 stand rejected under 35 U.S.C. §103(a) as unpatentable over Croda, Jacks, and Mercado as applied to claims 1-16, 18, and 19, and further in view of Natraj (U.S. 5,244,665) and Clement (U.S. 5,118,507). It

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is Applicants' contention that all of these rejections are addressed by the newly submitted amendments to the claims and the remarks which follow.

### **RESPONSE TO REJECTIONS:**

#### **Rejections under 35 U.S.C. §112, second paragraph:**

In response to the rejections under 35 U.S.C. §112, second paragraph, Applicants have taken the steps that follow to avoid or eliminate the basis for the rejection.

As to the rejection of claim 5 relating to the phrase "moderate to extensive branching", the phrase has been canceled from the claim.

As to the rejection of claim 7 relating to the antecedent basis for the phrase "the sterol", the claim has been modified to depend from claim 6, which provides proper antecedent basis for the phrase.

As to the rejection of claim 16 relating to the limitation "methyl", the claim has been modified to indicate that the variable being defined as "methyl" is  $R_3$  rather than  $R_1$ . Support for this amendment is found at page 7 of the specification, which provides that the preferred definition of  $R_3$  is  $C_1$  or methyl.

As to the rejection of claim 17, and thus also claim 18, regarding whether "the claim requires both octyldodecyl alcohol and isostearyl alcohol", claim 17 has been modified to indicate that the alcohol is either octyldodecyl alcohol, isostearyl alcohol, or mixtures thereof.

Applicants would urge that these amendments to the claims avoid all basis for the rejections set forth in the OA and would respectfully urge reconsideration of this ground of rejection.

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### **The Rejections Under 35 U.S.C. §103**

#### **The Rejection of Claims 1-16, 18 and 19:**

Starting at page 3 of the OA, the Examiner has set forth the basis for the rejection of currently pending claims 1-16, 18 and 19 under 35 U.S.C. §103(a) as being unpatentable over Jacks ('918) in view of the Croda publication (Croda) and Mercado ('044). While the statement of the rejection would suggest that the Examiner regards Jacks ('918) as the primary reference. The discussion that follows in support of the rejection would suggest that the Examiner regards Croda as the principle reference and that it is this reference taken in view of Jacks ('918) and Mercado ('044) which form the basis for this rejection. Applicants have addressed this rejection in respond to the reasoning set forth at pages 4-5 of the OA.

The Examiner initially notes that Croda teaches

a lipstick formulation comprising 1) 7.39% of C10-30 cholesterol/lanosterol esters; 33.63% of Oleyl alcohol; 7.712% of pigments. See Technical Data, p. 5 See p. 2, second par. The melting point of Super Sterol Ester is said to be 30-38 C. The reference teaches that Super Sterol Ester "produces elegant sticks, proving [sic] their skin feel and given them a creamy pay off", and exhibits excellent spreading ability and provides good adhesion properties to these anhydrous systems". See p. 2, second par. The ester is also said to be tasteless, clear, and "considered the ingredient of choice for lipsticks". See Id.

The Examiner acknowledges that "Croda fails to teach the claimed volatile oil." It is presumed that the Examiner meant that Croda fails to teach the claimed nonvolatile oil which claim 1 requires to be present in an amount of 10-90%.

However, the Examiner notes that (OA, pages 4-5):

Jacks teaches lipstick formulations comprising 1% of trioctyldodecyl citrate. See Examples. The reference teaches that to provide "desirable feel, spreadability, gloss and other desirable characteristics, a mixture of low viscosity and high viscosity oil soluble liquids are used. High viscosity oils include triesters of citric acids. See col. 5, line 66- col. 6, line 9. Example formulations also comprise cyclomethicone and acrylate

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copolymer. See instant claims 13 and 19. Polyethylene wax is also taught in col. 5, lines 35-40. While cetyl alcohol and oleyl alcohol are taught, the reference teaches these as low viscosity oils. See col. 5, lines 49-65.

The Examiner, at page 5, relies on Mercado ('044) as teaching:

cetyl alcohol and stearyl alcohol are wax feel enhancers and structure strengtheners useful for lipstick formulation. See col. 4, lines 8-18.

The Examiner concludes, at page 5, that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the lipstick composition of Croda by adding the triester of citric acid as motivated by Jacks because of the expectation of successfully producing a lipstick composition which provides good skin feel, spreading ability and gloss when applied. Selecting cetyl alcohol wax to make the composition of the combined references would have been also obvious in view of Mercado because of the expectation of successfully enhancing the feel of and strengthen the structure of the composition.

Applicants respectfully disagree with the conclusion reached.

The presently amended claims are directed to a lipstick composition comprising a stick structuring agent which is a solid or semi-solid at room temperature and has a melting point of 34 to 38° C, 10-90 % of a nonvolatile oil which is selected from the group consisting of triisostearyl citrate, trioctyldodecyl citrate or mixtures thereof, 1-30 % of a wax comprising a fatty alcohol and 0.1-25% of particulate matter having a particle size of .05 to 200 microns. (Claim 1). Claim 15 differs from claim 1 in defining the nonvolatile oil generically as being a guerbet alcohol ester of a defined carboxylic acid.

Croda discloses 2 lipstick related formulations at pages 4 and 5. Neither disclose or describe the presence of a nonvolatile oil which is a triisostearyl citrate, a trioctyldodecyl citrate or mixtures thereof as required by claim 1 or the generically defined nonvolatile oil of claim 15. In addition, Croda does not disclose or suggest the

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presence or need for a wax comprising a fatty alcohol.

While Jacks ('918) does disclose lipstick formulations that include 1% of trioctyldodecyl citrate, there is nothing present in Jacks ('918) that would reasonably be read to suggest the use of 10-90% of a nonvolatile oil in a lipstick composition. The only disclosure in Jacks ('918) that could reasonably be read as suggesting how much of the nonvolatile oil "trioctyldodecyl citrate" should be used in the formulations described appears at col. 6, lines 16-25. However, this disclosure does not specifically relate to trioctyldodecyl citrate and further describes the relative amount of a mixture of volatile and nonvolatile oils rather than the amount of an individual component. In fact, Jacks ('918) discloses compositions including a mixture of volatile and nonvolatile oils and it is this combination that provides the benefit mentioned by Jacks ('918). There is nothing that describes or suggests any benefit of including a nonvolatile oil in the absence of the volatile oil in a lipstick composition. Thus, there is nothing that would direct one of ordinary skill to incorporate 10-90%, as required by the present claims, of a particular nonvolatile oil into a lipstick composition.

Further, as noted by the Examiner, Jacks ('918) at col. 5, lines 49-51 states that the oily liquids "are included in the subject lipcare products to provide describable feel, spreadability, gloss and other desirable characteristics." Yet, Croda describing the use of the SUPER STEROL ESTER in lipsticks specifically states:

It produces elegant sticks, improving their skin feel and giving them a creamy payoff. It also exhibits excellent spreading ability and provides good adhesion properties to the anhydrous systems.

It is unclear why one of ordinary skill in this art would be led to incorporate the oily

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liquids of Jacks ('918) into the lipstick composition of Croda, giving that Croda's key ingredient (SUPER STEROL ESTER) offers essentially the same benefit as the oily material from Jacks ('918) does in the lipsticks described therein.

Mercado ('044), cited for describing wax feel enhancers such as cetyl alcohol and stearyl alcohol, does not provide that which is missing from the combination of Croda and Jacks ('918), i.e., a specific suggestion or direction which would have led one of ordinary skill in this art to incorporate a nonvolatile oil which is triisostearyl citrate, trioctyldodecyl citrate or mixtures thereof (Present claim 1) or the nonvolatile oil defined in pending claim 15, into the lipstick compositions disclosed by Croda in an amount of 10-90%. However, as the Examiner realizes, Croda does not suggest or describe the presence of this type of wax in the lipstick composition. However, again there is no reason, suggestion or direction that would have led one skilled in this art to incorporate the wax material of Mercado ('044) into the lipstick composition of Croda.

A conclusion of obviousness premised on a combination of references must identify a reason, suggestion, or motivation which would have led an inventor to combine those references. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629, (Fed. Cir. 1996). It is insufficient that the prior art discloses the components of the claimed invention, either separately or in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by appellants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor). Here, there is nothing that would have led one of ordinary skill in this art to incorporate the nonvolatile

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oil of Jacks ('918) into the lipstick composition of Croda in an amount of 10-90% of the composition. Mercado ('044) similarly fails to provide a teaching, suggestion or incentive to modify the composition of Croda in a manner to arrive at the claimed lipstick composition.

A conclusion of obviousness within the meaning of 35 U.S.C. §103(a) can not reasonably be based on such a combination of references absent something present in the prior art to suggest the modification of the primary reference in a manner to arrive at the claimed Invention. The references relied on and the reasoning provided fail to establish that just a suggestion exists in the prior art at the time of invention by Applicant. Therefore, Applicants, respectfully, request the Examiner to reconsider the rejection of claims 1-16, 18 and 19 and withdraw this rejection under 35 U.S.C. §103(a).

**The rejection of claims 17 and 20:**

At pages 5-7 of the OA of September 9, 2004 the Examiner has additionally rejected claims 17 and 20 as unpatentable over Croda, Jacks ('918) and Mercado ('044) as discussed in the rejection of claims 1-16, 18, and 19 and further in view of Natraj ('665) and Clement ('507).

The Examiner acknowledges that the combination of Croda, Jacks ('918) and Mercado ('044) fails to teach the use of triisostearyl citrate in the type of composition disclosed by Croda, Jacks ('918) and Mercado ('044).

However, the Examiner notes that Jacks ('918) teaches "Other triesters of citric acid, such as disclosed in US Pat. No. 5244665" may be used in place of some or all of the trioctyldodecyl citrate. See col. 6, lines 2-6"

Natraj ('665) is stated to teach triesters of citric acid defined generically (OA, page 6)

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which generic teaching is said to encompass or include the triisostearyl citrate if Applicants' claims. The Examiner states that the reference "teaches that the triesters are used to treat photodamaged and/or hyperpigmented skin, and to slow down aging process generally. See col. 2, lines 3-11."

The Examiner urges that Clement ('507) "teaches that a combination of volatile silicone fluid, a non-volatile silicone gum and a C16-22 fatty acid ester of citric acid produces a cosmetically desirable tacky feeling. Triisostearyl citrate is particularly demonstrated in the reference. See Examples."

Thus, the Examiner concludes that (paragraph bridging pages 6-7):

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by substituting the trioctyldodecyl citrate with triisostearyl citrate as motivated by Natraj and Clement because 1) all the references are in cosmetic art known to the routineer; 2) Jacks teaches that triisostearyl citrate is within the scope of the suitable citric acid trimesters for the lipstick formulation; and 3) Clement teaches that trioctyldodecyl citrate produces a cosmetically desirable properties when combined with volatile and nonvolatile silicone compounds which are also used in Jacks formulations (cyclomethicone, silicone gum). In combining the teaches of these references, the routineer would have had a reasonable expectation of successfully producing a lipstick composition, which produces a cosmetically desirable tacky feeling.

Applicants, respectfully, urges that the conclusion reached is not supported by references relied upon.

Initially, Applicants would urge that to the extent this rejection relies on the combination of Croda, Jacks ('918) and Mercado ('044) it is not sustainable for the reasons set forth above with regard to the rejection of claims 1-16, 18 and 19.

In addition, the Examiner has acknowledged that none of these three references disclose the use in a lipstick composition of triisostearyl citrate, which is specifically required by claims 17 and 20 and, also, must be present in an amount of 10-90%.



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Applicants would note that Natraj ('665) does not explicitly disclose or describe the use of triisostearyl citrate in a lipstick composition. The portion of the reference to which the Examiner refers discloses a group of generically defined esters of citric acid. However, this generic disclosure encompasses literally thousands of compounds, one of which may be the claim designated triisostearyl citrate. However, there is nothing present in Natraj ('665) that would direct one of ordinary skill in this art to a particular ester other than those defined in column 3, lines 1-44. Missing from this list is the triisostearyl citrate in question. Further, Natraj ('665) does not disclose any lipstick compositions. It is not readily apparent why one would select from Natraj ('665) a particular ingredient, only identified generically to be incorporated into the lipstick composition of Croda, absent more of a suggestion or direction to be found in the prior art to do so.

Clement ('507) does not provide that which is missing from the other references. As with Natraj ('665), Clement ('507) does not relate to lipstick compositions and even specifies that the compositions are intended for "application to areas surrounding the eye" (Abstract). Further, Clement ('507) states that the fatty acid esters of citric acid should be used in combination with silicones (col. 2, lines 3-4). Applicants would also urge that the benefit attributed to the composition of Clement ('507) that the resulting composition would result in a "slightly tacky consumer-appealing residue." While such a tacky feel might be desirable in an eye make-up, such a feel would not be desirable in a lipstick. In fact, the only suggestion or teaching which would direct one of ordinary skill in this art to use any component from either Natraj ('665) or Clement ('507) into the lipstick composition of Croda is found only in Applicants' disclosure of the invention in the

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specification and claims. However, use of that information would constitute impermissible hindsight in the construction of the rejection under 35 U.S.C. §103(a). In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, as set forth in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) "To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the [applicants]. Here, there is no such motivation, suggestion or teaching which would have reasonably led those skilled in this art to bring together the ingredients required by claims 17 and 20.

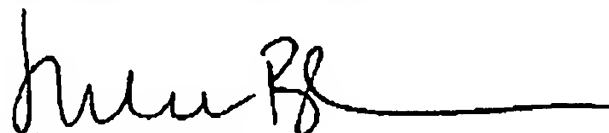
Thus, Applicants would urge the Examiner to reconsider the rejection of claims 17 and 20 under 35 U.S.C. §103(a) over the combination of Croda, Jacks and Mercado when taken in further view of Natraj ('665) and Clement ('507).

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**Conclusion:**

In conclusion, applicants have presented amendments and arguments relating to those rejections set forth in the Office action of September 9, 2004. Applicants respectfully request that the Examiner reconsider these rejections as they might be applied to the presently amended claims and find all claims allowable.

Respectfully Submitted,



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